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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,587	11/04/2005	Rory McCreesh	D011-4740 (PCT)	1613
7590	11/15/2006		EXAMINER	
Bruce L. Adams Adams & Wilks 17 Battery Place - Suite 1231 New York, NY 10004			THOMAS, DAVID B	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/550,587

Applicant(s)

MCCREESH, RORY

Examiner

David B. Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,11-30 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,11-30 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 21, 27, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Braun (6,286,216).

Braun ('216) discloses a “multi-purpose” tool for making circular cuts, the tool comprising a first member 28 having a first and second portion, a second member 40, where the second member 40 is pivotally and slidably coupled to the first member via a threaded releasable locking member and a boss 50 through an elongate slot 48 in the first member, the second member being adjustable in order to provide arcs of different dimensions (see Fig. 2).

2. Claims 1, 27, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Silver (2,557,699).

Silver ('699) discloses a multi-purpose hand tool having a first member having a first and a second portion; a second member slidably and pivotally coupled to the second portion of the first member; a coupling assembly; means for pivotally coupling the second member to the first; the coupling means comprising a boss and a releasable locking mechanism, the locking mechanism having a knob with a threaded joint and fastener; the first member including a cutout region to afford sliding movement between

the first and the second member; and a retractable needle assembly.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silver ('699), as applied to claims 1, 27, and 35 above, in view of Warwicker (GB 2155406).

Silver ('699), as applied to claims 1, 27, and 35 above, discloses the invention as claimed, except for the provision of a sharpener and "color coded" measuring scales. Warwicker ('406) discloses a ruler, which inherently includes measuring scales, and teaches among other features, that it would be desirable to provide such device with a pencil sharpener. The examiner notes that claim 17 merely recites the limitation that the measuring scales are "color-coded", which is limiting in the sense that further defines the measuring scale of claim 16, however, "color" is not a structure, and as such the examiner takes official notice that among the art of measuring and indication, the use of color-coded measurement scales is well known. The examiner also respectfully contends that the device of Silver ('699) inherently relies upon measurement during use of the device, although Silver ('699) is not explicit. Furthermore, the examiner considers the device of Silver ('699) and the device of Warwicker ('406) as equivalents in the art. Therefore, it would have been obvious to one having ordinary skill in the art of

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measuring and scribing, to have modified the multi-purpose tool of Silver ('699) by providing measuring scales, in order to provide a user of the tool the means to select appropriate positions for the retractable needle assembly prior to use, or in order to assess a measurement after employing the tool, and further providing a pencil sharpener on the tool, such as taught by Warwicker ('406), wherein the provision of the pencil sharpener serves to provide a convenient means of maintaining a sharp point on a pencil used with the device.

4. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silver ('699), as applied to claims 1, 27, and 35 above, in view of Decker (4,656,744).

Silver ('699), as applied to claims 1, 27, and 35 above, discloses the invention as claimed except for explicitly providing a marking pencil rest. Decker ('744) discloses a scribing tool. Decker ('744) teaches the provision of a slidable marking pencil rest means for the scribing device, the purpose of which is to provide a secure means for maintaining the position of the pencil relative to the scribe during use. Therefore, it would have been obvious to one having skill in the art at the time the invention was made to have modified the multi-purpose scribing tool of Silver ('699) by providing a slidable marking pencil rest means on the tool, as Decker ('744) teaches that the provision of a pencil rest on a scribing tool provides an improved arrangement for effecting the accurate marking of irregular contact lines on wall panels and the like.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

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identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1, 6, 11-30, and 35-37 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-39 of prior U.S. Patent No. 6,941,605. This is a double patenting rejection.

Conclusion

5. The remaining prior art made of record but not relied upon, at this time, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. Thomas whose telephone number is (571) 272-4497. The examiner can normally be reached on Mon-Fri 8am-7pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dbt



David B. Thomas
Primary Examiner
Art Unit 3723